

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent of

CLARK et al.

U.S. Patent No. 7,569,602 B2; issued August 4, 2009

Atty. Ref.: 620-432; Confirmation No. 1721

Appl. No. 10/576,095

TC/A.U. 1626

Filed: April 14, 2006

Examiner: SHAMEEM, Golam M.

For: FURAN DERIVATIVES AS EP4 RECEPTOR ANTAGONISTS

\* \* \* \* \*

**September 11, 2009**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attn: Office of Patent Legal Administration

Sir:

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT**  
**PURSUANT TO 37 CFR § 1.705(d)**

This Request for Reconsideration of Patent Term Adjustment is being filed within two (2) months of the issue date of the above-identified patent. This Request concerns issues that arose after payment of the issue fee. Therefore this Request is timely (37 CFR 1.705(d)). The fee set forth in 37 CFR 1.18(e) is being paid concurrently.

Patentees respectfully request reconsideration of the Patent Term Adjustment for this patent.

The Patent Office determined that the patent is entitled to a term adjustment of **462 days**.

The correct term adjustment is not less than **574 days**.

### **ISSUE PRESENTED**

This patent is entitled to a term extension equal to the sum of: (A) Office delays in taking certain actions; and (B) the amount of time, in excess of three years from the filing date, that it took for the patent to be issued.

The Patent Office Patent Term Adjustment calculation indicated on the issued patent fails to include the additional amount of time in excess of three years from the filing date that it took for the patent to be issued, as required by 35 U.S.C. § 154(b)(1)(B).

### **LAW OF PATENT TERM ADJUSTMENT**

The term of a patent is extended for the number of days that issuance of the patent was delayed by failures of the Patent Office to promptly take certain actions (35 U.S.C. § 154(b)(1)(A)) ("A delays"). The term of a patent is also extended for the number of days that the Patent Office failed to issue a patent by the three-year anniversary of the date that the application for patent was filed (35 U.S.C. § 154(b)(1)(B)) ("B delay"). Relevant to the present facts, the Patent Term Adjustment is calculated by adding the "A delays" plus the "B delay," except to the extent that the periods of delay overlap (35 U.S.C. § 154(b)(2)(A))<sup>1</sup>. "B delay" begins when the Patent

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<sup>1</sup> There are "C delays" resulting from interferences, secrecy orders, and appeals, which are similarly treated but are not relevant to the present facts.

Office has failed to issue a patent within three years, not before.” *Wyeth v. Dudas*, 580 F. Supp. 2d 138, 142 (D.D.C. 2008). Therefore a “B delay” does not overlap with “A delays” that occurred during the first three years that a patent application was pending. *Id.* at 141.

In this case the Patent Office is believed to have calculated the Patent Term Adjustment in accordance with its earlier, contrary “position that . . . the entire period during which the application was pending before the Office . . . and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay ‘overlap’ under 35 U.S.C. 154(b)(2)(A).” 69 Fed. Reg. 34283 (June 21, 2004), as excerpted from *Wyeth v. Dudas*, 580 F. Supp. 2d 138, 140 (D.D.C. 2008). The Patent Office’s position is “inconsistent with law” (*See* 35 U.S.C. § 2(b)(2)) as interpreted by the court in *Wyeth*.

#### **“A DELAYS”**

Relevant to the present facts, the period of adjustment under 37 CFR 1.702(a) includes the following period:

(1) “The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application . . . fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of . . . an action under 35 U.S.C. 132. . . .” *See* 37 CFR § 1.703(a)(1)). The application entered national phase on April 14, 2006 and the first Office Action was mailed on September 18, 2008. The

day after the date that is fourteen months after the application entered national phase was June 15, 2007. The Patent Office delay was **462 days**, which is the number of days in the period from June 15, 2007 to September 18, 2008.

The total "A delay" was **462 days**, which is the total Patent Term Adjustment stated on the above-identified patent.

#### **"B DELAY"**

"The period of adjustment under [37 CFR] § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which . . . the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued. . . ." See 37 CFR § 1.703(b).

The patent application commenced national stage on April 14, 2006 and the patent issued on August 4, 2009. The day after the date that is three years after commencement of national stage was April 15, 2009. And the total "B delay" was **112 days**, which is the number of days in the period from April 15, 2009 to August 4, 2009.

#### **CALCULATION OF PATENT TERM ADJUSTMENT**

All of the "A delay" occurred during the first three years that the patent application was pending. The above-noted "A delay" of **462 days** occurred prior to the period beginning on the day after the date that is three years after the date on which the

national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued.

Accordingly, under *Wyeth*, there is no overlap between the "A delays" and the "B delay" in this case. Therefore, the period of adjustment due to Patent Office delays is **574 days**, which is the sum of the **462 days** of "A delays" and the **112 days** of "B delay."

The period of Patent Office delay is "reduced by . . . the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution" (37 CFR 1.704), which the Office determined to be **0 days**. There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth in 37 CFR § 1.704.

Thus the total Patent Term Adjustment is not less than **574 days**.

The patent is not subject to a terminal disclaimer. 37 CFR 1.703(g).

A copy of the Patent Term Adjustment History calculation printed from the Patent Office IFW is attached.

No fee, other than the fee under 37 CFR 1.18(e), is believed to be necessary in connection with the filing of this paper. If any additional fee is required, the Director is authorized to charge the additional fee to Deposit Account No. 14-1140.

Grant of the present Request, correction of the Patent Office records and a Certificate of Correction or other appropriate correcting paper indicating the correct Patent Term Adjustment on the face of the issued patent are requested.

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Atty. Ref.: 620-432  
September 11, 2009  
REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT  
PURSUANT TO 37 CFR § 1.705(d)

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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| 10/576,095 | FURAN DERIVATIVES AS EP4 RECEPTOR ANTAGONISTS | 08-27-<br>2009::09:44:46 |
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### Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/576,095

|                              |            |                                      |     |
|------------------------------|------------|--------------------------------------|-----|
| Filing or 371(c) Date:       | 04-14-2006 | USPTO Delay (PTO) Delay (days):      | 462 |
| Issue Date of Patent:        | 08-04-2009 | Three Years:                         | -   |
| Pre-Issue Petitions (days):  | +0         | Applicant Delay (APPL) Delay (days): | 0   |
| Post-Issue Petitions (days): | +0         | Total PTA (days):                    | 462 |
| USPTO Adjustment(days):      | +0         | Explanation Of Calculations          |     |

### Patent Term Adjustment History

| Date       | Contents Description   | PTO(Days) | APPL(Days) |
|------------|--|-----------|------------|
| 07-15-2009 | PTA 36 Months  |           |            |
| 08-04-2009 | Patent Issue Date Used in PTA Calculation                      |           |            |
| 06-26-2009 | Dispatch to FDC  |           |            |
| 06-26-2009 | Application Is Considered Ready for Issue                      |           |            |
| 06-25-2009 | Issue Fee Payment Verified                                     |           |            |
| 06-25-2009 | Issue Fee Payment Received                                     |           |            |
| 03-31-2009 | Mail Notice of Allowance                                       |           |            |
| 03-27-2009 | Document Verification  |           |            |
| 03-27-2009 | Notice of Allowance Data Verification Completed                |           |            |
| 03-27-2009 | Case Docketed to Examiner in GAU                               |           |            |
| 03-12-2009 | Date Forwarded to Examiner                                     |           |            |
| 01-21-2009 | Response after Non-Final Action                                |           |            |
| 10-31-2008 | Mail Non-Final Rejection                                       |           |            |
| 10-28-2008 | Non-Final Rejection  |           |            |
| 04-14-2006 | Information Disclosure Statement considered                    |           |            |
| 10-17-2008 | Information Disclosure Statement considered                    |           |            |
| 10-17-2008 | Reference capture on IDS                                       |           |            |
| 10-17-2008 | Information Disclosure Statement (IDS) Filed                   |           |            |
| 10-23-2008 | Date Forwarded to Examiner                                     |           |            |
| 10-17-2008 | Response to Election / Restriction Filed                       |           |            |
| 10-17-2008 | Information Disclosure Statement (IDS) Filed                   |           |            |
| 09-18-2008 | Mail Restriction Requirement                                   | 462       |            |
| 09-17-2008 | Requirement for Restriction / Election                         | ⚡         |            |
| 12-08-2007 | Case Docketed to Examiner in GAU                               | ⚡         |            |
| 06-14-2007 | PG-Pub Issue Notification                                      | ⚡         |            |
| 04-14-2007 | IFW TSS Processing by Tech Center Complete                     | ⚡         |            |
| 01-30-2007 | Miscellaneous Incoming Letter                                  | ⚡         |            |
| 04-14-2006 | Request for Foreign Priority (Priority Papers May Be Included) | ⚡         |            |
| 04-14-2006 | Information Disclosure Statement (IDS) Filed                   | ⚡         |            |
| 04-14-2006 | Information Disclosure Statement (IDS) Filed                   | ⚡         |            |

|            |                                   |   |
|------------|-----------------------------------|---|
| 04-14-2006 | Preliminary Amendment             | ✎ |
| 03-28-2007 | Application Dispatched from OIPE  | ✎ |
| 04-14-2006 | 371 Completion Date               | ✎ |
| 03-14-2007 | Sent to Classification Contractor |   |
| 03-14-2007 | Notice of DO/EO Acceptance Mailed |   |
| 05-16-2006 | Cleared by OIPE CSR               |   |
| 04-14-2006 | Initial Exam Team nn              |   |

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